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EXAMINER

PHAM, HUONG Q

ART UNIT PAPER NUMBER

3764

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,271

Applicant(s)

NICKSON, SHANE WILLARD

Examiner

Huong Q. Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities:

1) On page 9, it is unclear what structure is the "strapping member 22", or the "strapping portion".

Appropriate correction is required.

2) The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1) Claims 13-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Note that the terms "flexible" and "inflexible" in claims 13-16 are relative terms which render the claim indefinite. It is unclear what structure or material is considered to be "flexible" or "inflexible". One of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 18 appears to be incomplete or unfinished.

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The following terms lack proper antecedent basis: " the outer side" and "the position" (claim 13), " the flexible portions" and " the inflexible portion" (claim 14), " the area" and " portions" (claims 15 and 16), " the inside" (claim 23).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1) Claims 13, 17 and 18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hall. Note that Hall shows very claimed feature of claims 13, 17 and 18 with the teaching that yoke 30 has a structure which is sufficiently flexible to permit the foot and leg to flex .

13, 17, 18, 19, 20, 21
2) Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hall as applied to claims 13, 17 and 18 above, and further in view of the publication WO 95/31950. While Hall does not teach the materials as recited in claim 14, the

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publication WO 95/31950 teaches a joint orthosis with reinforcement elements 2A , 2B made of different materials that has different degree of stiffness such as carbon fibre reinforced plastic resin and fibreglass reinforced plastic resin. In view of this teaching of the publication WO 95/31950, it would have been obvious to an ordinary skill in the art at the time the invention was made to use different materials as recited in claim 14 for the brace of Hall in order to provide different degree of stiffness or permit relative flexibility between two parts of a reinforcement element.

3) Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hall as applied to claims 13, 17 and 18 above, and further in view of Willner et al. While Hall does not mention about a sole plate with different portions having different strength and flexibility, Willner et al teaches a footplate 5 with this structure. In view of the teaching of Willner et al, it would have been obvious to an ordinary skill in the art at the time the invention was made to provide the foot pad 40 of Hall with different portions having different strength and flexibility in order to allow flexion of the foot and promote a more natural gait.

4) Claims ~~16~~, and ~~19-21~~ are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall as applied to claims 13, 17 and 18 above, and further in view of the publication WO 95/31950 and/or Willner et al. As regards to claim 16, note the comments relative to claim 15 for the teaching of Willner et al. As regards to claims 19-21, note that the publication WO 95/31950 and Willner et al both teach a reinforced element encased in a sleeve of plastic material. In view of the teaching of the publication WO 95/31950 and/or Willner et al, it would have been obvious to an ordinary

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skill in the art at the time the invention was made to encase the brace of Hall in a sleeve of plastic material in order to provide the brace with flexibility and good fit at a certain area of the leg of a wearer.

5) Claims 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall as applied to claims 13, 17 and 18 above, and further in view of DeToro and/or DiBenedetto. While Hall does not teach fasteners and a channel for the stiffener to allow adjustability, DeToro and DiBenedetto clearly teach this structure for a brace. In view of the teaching of DeToro and/or DiBenedetto, it would have been obvious to an ordinary skill in the art at the time the invention was made to provide fasteners and a channel as recited in claims 22-25 for the brace of Hall in order to provide adjustability and good fit. The provision of an adjusting means for a brace in order to provide a good fit for a wearer is well known in the art, and provides no unexpected result, and is only a matter of obvious engineering design choice, and therefore is not patentably distinct from prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huong Q. Pham whose telephone number is (703) 305-5129. The examiner can normally be reached on 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on (703) 308 - 2698. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



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SUPERVISORY PATENT EXAMINER
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February 21, 2003